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09/865,774	05/25/2001	Timothy Wells	2620	5773

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EXAMINER

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ART UNIT PAPER NUMBER

3731

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 19

Application Number: 09/865,774
Filing Date: May 25, 2001
Appellant(s): WELLS ET AL.

Christopher G. Trainor
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the reply brief filed February 4, 2004.

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Response to Argument

Applicant argues that U.S. Patent No. 5,674,237 to Ott and U.S. Patent No. 5,928,154 to Silber et al. have opposing goals and thus there is no incentive to combine these references. However, the Silber '154 reference teaches a grip layer made of a low durometer material to provide "a grip layer having high friction characteristics to allow for good control of the probe with maximized comfort and control to the user's hand." (Column 8 lines 2-6) The trocar disclosed by Ott '237 is modified to include a grip layer to allow for good control of the trocar while maximizing comfort as taught by Silber '154.

Applicant goes on to argue that the coating of Silber '154 is rigid and therefore cannot be considered to have a cushioning effect. However, Silber '154 discloses that the grip layer is substantially non-compressible (Column 3 lines 17-19) and substantially rigid (Column 4 lines 1-3) and can be formed out of a low durometer thermoplastic elastomer (Column 3 lines 63-64). Since the layer is formed of a material that is *substantially* non-compressible, *substantially* rigid, and low durometer, the layer must provide some resilience and thus inherently has a cushioning effect to provide maximum comfort to a user's hand.

Applicant states, on page 3 of the Reply Brief, that Silber '154 provides a "thin, rigid coating." However, Silber '154 provides a *substantially* rigid (Column 4 lines 1-3) layer. The term *substantially* indicates that it is not completely rigid and thus the material must inherently have some resilience.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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April 12, 2004



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